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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Interstate Packaging Corporation

Serial No. 74/496,567

Evelyn M. Sommer for Interstate Packaging Corporation.

Robert C. Clark, Jr., Trademark Examining Attorney,
Law Office 108 (David Shallant, Managing Attorney)

Before Sams, Seeherman and Hanak, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Interstate Packaging Corporation (applicant) seeks to register JUMBO in typed capital letters for "plastic or paper bags for merchandise packaging." The application was filed on March 3, 1994 with a claimed first use date of January 10, 1964. Initially, applicant sought to register the mark JUMBO for "shopping bags." Applicant noted that it was the owner of Registration No. 951,611 for JUMBO for "shopping bags," and that applicant had inadvertently failed to renew the registration in 1993. This Registration No.

951,611 issued to applicant's predecessor on January 30, 1973 with the same claimed first use date of January 10, 1964. At the request of the Examining Attorney, applicant agreed to modify its identification of goods from "shopping bags" to "plastic or paper bags for merchandise packaging."

In the first office action, registration was refused pursuant to Section 2(e)(1) of the Lanham Trademark Act on the basis that applicant's mark is merely descriptive of its goods. However, the Examining Attorney suggested that applicant "amend to seek registration under Trademark Act Section 2(f) based on acquired distinctiveness" by submitting the following "claim of distinctiveness": "The mark has become distinctive of the goods through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement." In response, applicant submitted the aforementioned claim of distinctiveness.

In Office Action No. 2, the new Examining Attorney, without providing any explanation whatsoever, simply stated that applicant's showing of acquired distinctiveness was insufficient. In support of his contention that applicant's mark was merely descriptive, the Examining Attorney made of record excerpts from 17 stories from the NEXIS database where the term "jumbo" was used to describe various types of bags or sacks.

In response, applicant submitted the declaration of applicant's president as well as numerous specimens of sales

sheets and invoices evidencing significant sales of plastic and paper bags for merchandise packaging under the mark JUMBO.

In the third and final office action, the Examining Attorney dismissed applicant's evidence of acquired distinctiveness and stated again that "JUMBO is merely descriptive of applicant's shopping bags." (Of course, at this point, applicant's identification of goods was not "shopping bags,"; rather it was, as suggested by the first Examining Attorney, "plastic or paper bags for merchandise packaging.").

Subsequently, applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

Despite the fact that in all three office actions the ground of refusal was that applicant's mark JUMBO was merely descriptive of applicant's goods, in his brief, the present Examining Attorney argued for the first time that JUMBO was a generic term for a type of shopping bag (Examining Attorney's brief page 2), and that therefore "the question of whether or not it [JUMBO] has acquired secondary meaning is irrelevant." (Examining Attorney's brief page 4). In its reply brief, applicant noted that the Examining Attorney was setting forth a new ground for refusal (genericness) which applicant had not had the opportunity to address either during the examination process or in its initial brief on appeal. We concur with the applicant, and find the Examining Attorney's approach to be troublesome.

Nevertheless, we elect to consider whether the Examining Attorney has proven that the term JUMBO is generic for "plastic or paper bags for merchandise packaging," and if it is not, whether applicant has established that the term JUMBO has become distinctive (i.e. indicating a particular source) when used in conjunction with these type of bags.

At the outset, we note that the burden is on the Examining Attorney to establish that the mark JUMBO is generic as applied to applicant's goods. In re Merrill Lynch, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Moreover, our primary reviewing Court has stated that it is incumbent upon the Examining Attorney to make a "substantial showing ... that the matter is in fact generic." Merrill Lynch, 4 USPQ2d at 1143. Indeed, this substantial showing "must be based on clear evidence of generic use." Merrill Lynch, 4 USPQ2d at 1143. Thus, it is quite clear that a "strong showing is required when the Office seeks to establish that a term is generic." In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Moreover, any doubt whatsoever on the issue of genericness must be resolved in favor of the applicant. In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993). In addition, it is critical to remember that the purported genericness of a mark is determined in relation to the particular goods or services for which registration is sought, and from the view of "the relevant public which does or may purchase the goods or services" for which registration is sought. Magic Wand

Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991).

As previously noted, the only evidence made of record by the Examining Attorney are excerpts from 17 stories taken from the NEXIS database. However, as the Examining Attorney acknowledges, not all of "the excerpts submitted ... specifically refer to the type of bags manufactured and sold by applicant." (Examining Attorney's brief page 3). Indeed, of the 17 excerpts, there are, at the very most, only 4 which refer to the type of bags for which applicant seeks registration of the term JUMBO (i.e. excerpts 1, 3, 12 and 14). Moreover, in reviewing these 4 excerpts, it appears that the term "jumbo" is used in a descriptive, and not in a generic manner. Indeed, in all 17 excerpts the term "jumbo" is used to describe various types of bags or sacks. In not one of the 17 excerpts is the term "jumbo" used in a manner such that it is clear that "jumbo" is a generic term for a type of bag. Thus, we find that the Examining Attorney has fallen far short of providing, as required by case law, "clear evidence of generic use." Merrill Lynch, 4 USPQ2d at 1143. Indeed, the Examining Attorney's evidence does not begin to measure up to the "strong showing ... required when the Office seeks to establish that a term is generic." K-T Zoe Furniture Inc., 29 USPQ2d at 1788.

Having found that on this record it has not been established that JUMBO is generic for "plastic or paper bags

for merchandise packaging," we turn next to consider applicant's evidence that the descriptive term JUMBO has become distinctive of applicant's goods. Applicant has established that it and its predecessors have made continuous use of the mark JUMBO in connection with the goods in question for well over thirty years. In addition, as previously noted, applicant has made of record evidence showing that sales of bags bearing the mark JUMBO by applicant and its predecessors have been substantial. Accordingly, we find that applicant has established that JUMBO has become distinctive of "plastic or paper bags for merchandise packaging."

Decision: The refusal to register is reversed.

J. D. Sams

E. J. Seeherman

E. W. Hanak
Administrative Trademark
Judges, Trademark Trial
and Appeal Board